

REMARKS

The examiner is thanked for a thorough examination of the present patent application.

Claims 1-23 are pending with Claims 1, 12, and 17 being Independent Claim. Claims 1, 2, 3, 12, 13, 17, 18, and 19 are currently amended.

In this document, the term “applicant” indicates and includes both singular “applicant” and plural “applicants.”

I. REJECTIONS UNDER 35 USC 102(b)

Claim 1 was rejected under 35 U.S.C. 102(b) as being anticipated by Kobachi et. al. (US 6,326,948). Office Action, p. 2. The applicant respectfully traverses the rejection. Nonetheless, the applicant currently amends, without prejudice, Claim 1 to recite the present invention with even more clarity.

“A claim is anticipated only if **each and every element** as set forth in the claim is found ... in a single prior art reference.” *Verdegall Bros. v. Union Oil Co. of California*, 814 f.2d 628, 631, USQP2D 1051 (Fed. Cir. 1987) (Emphasis added). In fact, for a valid rejection under 35 U.S.C. 102(b), “[t]he **identical invention** must be shown in as **complete detail** as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989) (Emphasis added). Moreover, “**All words** in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494 (CCPA 1970) (Emphasis added).

Further, “it is fundamental that **claims are to be construed in light of the specifications** and both are to be read with a view to ascertaining the invention.” E.g.,

Adams v. United States, 383 U.S. 39, 49 (1966). “Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim.” MPEP 2106 citing *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a “lexicographic vacuum, but in the context of the specification and drawings.”); see, also, *In re Vogel*, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970).

Here, Claim 1, currently amended, recites, *inter alia*, “a horizontal spring allowing resistive movement of said captive disc in horizontal direction; and a vertical spring allowing resistive movement of said captive disc in vertical direction.”

The Kobachi reference fails to teach both the horizontal spring and the vertical spring. The rejection alleges that the “elastic structure 2” of the Kobachi reference anticipates both the “horizontal spring” and the “vertical spring” of the present invention. Office Action, pp. 2-3. The applicant respectfully traverses. Firstly, in the present invention, the “horizontal spring” and the “vertical spring” are two separate limitations. Accordingly, the elastic structure 2 of the Kobachi reference cannot anticipate both of these limitations.

More importantly, the elastic structure 2 of the Kobachi reference cannot anticipate the “vertical spring” of the present invention because, in the Kobachi reference, such vertical spring is not needed. This is because the alleged disc (the “operating portion 1”) of the Kobachi reference has no vertical movements at all. In fact, the alleged disc 1 is placed directly on a “base 4” where no vertical movement is possible. Accordingly, and again, the elastic structure 2 need not, and does not, provide any spring action in the vertical direction; thus the elastic structure 2 cannot anticipate the “vertical spring” of the present invention.

For at least these reasons, the applicant respectfully submits that Claim 1, currently amended, is allowable over the cited prior art reference.

Claims 2–6 and 8–11 were rejected under 35 U.S.C. 102(b) as being anticipated by the Kobachi reference. Office Action, p. 2. The applicant respectfully traverses the rejection. Claims 2–6 and 8–11 depend, directly or ultimately, from Independent Claim 1, currently amended. As discussed above, Claim 1, currently amended, is not anticipated by the cited prior art reference. Accordingly, the applicant respectfully submits that Claims 2–6 and 8–11 are allowable for at least the same reasons for which Claim 1 is allowable. See, e.g., *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Please note that Claims 2 and 3 are currently amended, without prejudice, to be consistent with the amendments of Claim 1.

Independent Claim 17 was rejected under 35 USC 102(1) as being anticipated by the Kobachi reference. The applicant respectfully traverses. Independent Claim 17, currently amended, recites the present invention having a different scope than that of Independent Claim 1, currently amended, but having similar limitations as Claim 1. Additionally, Claim 17 is currently amended in a similar manner as Claim 1. Accordingly, the applicant respectfully submits that Claim 17, currently amended, is allowable for at least the same reasons for which Claims 1, currently amended, is allowable as discussed above.

Claims 18–21 and 23 were rejected under 35 U.S.C. 102(b) as being anticipated by the Kobachi reference. Office Action, p. 2. The applicant respectfully traverses the rejection. Claims 18–21 and 23 depend, directly or ultimately, from Independent Claim 17, currently amended. As discussed above, Claim 17, currently amended, is not anticipated by the cited prior art reference. Accordingly, the applicant respectfully submits that Claims 18–21 and 23 are allowable for at least the same reasons for which Claim 17 is allowable. See, e.g., *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Please note that Claims 18 and 19 are currently amended, without prejudice, to be consistent with the amendments of Claim 1.

II. REJECTIONS OF CLAIMS UNDER 35 USC 103(a)

Claim 7 was rejected under 35 USC 103(a) as being unpatentable over the Kobachi reference in view of Liao (US 2004/0075640). Office Action, p. 6 et seq. The applicant respectfully traverses.

For a valid rejection under 35 U.S.C. 103(a), “[t]he **examiner bears the initial burden** of factually supporting any *prima facie* conclusion of obviousness.” MPEP Ed. 8 Rev. 2, Sec. 2142 (italic in the original; bold added). “The PTO bears the burden of establishing a case of *prima facie* obviousness.” *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966),

“To establish a *prima facie* case of obviousness, three basic criteria must be met. **First**, there **must** be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. **Second**, there **must** be a reasonable expectation of success. **Finally**, the prior art reference (or references when combined) **must** teach or suggest all the claim limitations.” MPEP Ed. 8 Rev. 2, Sec. 2142 (italic in the original; bold added), citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Further, “[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success **must both be found in the prior art**, and not based on applicant’s disclosure.” *Id.* (bold added). In fact, “The mere fact that reference can be combined or modified does not render the resultant combination obvious **unless the prior art also suggests** the desirability of the combination.” MPEP Ed. 8 Rev. 2, Sec. 2143.01 (underline in the original, bold added), citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Again, there must be a suggestion or motivation **in the reference** to do so.” *In re Mills*, 916 F.2d at 682, 16 USPQ2d at 1432 (emphasis added).

Claim 7 depends from Claim 2 which, in turn, depends from Independent Claim 1, currently amended. The applicant respectfully submits that Claim 7 is allowable over the cited prior art references for at least the following reasons.

Firstly, there is no suggestion to combine the references. The rejection nakedly alleges, without any foundation or citation, that

“it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Liao in the apparatus of Kobachi to include a focusing lens between the active surface and the sensor in order to narrow the beam of light reflected off the active surface.”

Office Action, p. 6. The applicant respectfully traverses.

Not only do the cited references lack any suggestion or motivation to combine, it would be highly unlikely that these two references would be combined. This is because, for example, in the “pointing device P” of the of the Kobachi reference, its “sensor S” is proximal to its disc 1. In fact, not only is such lens (50 of the Liao reference) not needed by the Kobachi device, it is not likely to fit in the Kobachi device. As illustrated by the Figures of the Kobachi device, there is very little room between its disc 1 and its sensor S such that such lens (50 of the Liao reference) is not needed, cannot fit, or both. See, e.g., Kobachi Figures 1, 3, 11, 20A-20E, 21B, 22B, 23B, 25, 26B, 27, 31, and 33.

Furthermore, even if combined, the cited prior art references do not and cannot render Claim 7 obvious. This is because, for example, even if combined, the cited prior art references do not teach the vertical spring recited by Claim 7 as explained above related to Claim 1.

For at least these reasons, the applicant respectfully submits that Claim 7 is allowable over the cited prior art references.

Claim 12 was rejected under 35 USC 103(a) as being unpatentable over the Kobachi reference in view of the Liao reference. Office Action, p. 6 et seq. The applicant respectfully traverses.

Independent Claim 12, currently amended, recites the present invention having a different scope than that of Claim 7, but having similar limitations as Claim 7 which depends, ultimately, from Claim 1, currently amended. Additionally, Claim 12 is currently amended in a similar manner as Claim 1. Accordingly, the applicant respectfully submits that Claim 12, currently amended, is allowable for at least the same reasons for which Claim 7 is allowable as discussed above.

Claims 13–16 were rejected under 35 USC 103(a) as being unpatentable over the Kobachi reference in view of the Liao reference. Office Action, p. 6 et seq. The applicant respectfully traverses. Claims 13–16 depend, directly or ultimately, from Independent Claim 12, currently amended. As discussed above, Claim 12, currently amended, is not anticipated by the cited prior art references. Accordingly, the applicant respectfully submits that Claims 13–16 are allowable for at least the same reasons for which Claim 12 is allowable. See, e.g., *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Please note that Claim 13 is currently amended, without prejudice, to be consistent with the amendments of Claim 12.

III. PRIOR ART MADE OF RECORD BUT NOTE RELIED UPON

The applicant respectfully submits that the prior art references made of record and not relied upon by the Office Action, alone or in any combination, do not prevent allowance of the Claims.

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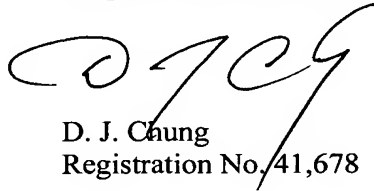
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Application no. 10/651,589
Response and Amendment dated 01/31/2006
in Reply to Office Action dated 11/01/2005

CONCLUSION

In view of the foregoing Remarks, the applicant respectfully submits that the entire application is in condition for allowance. The applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,



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